

REMARKS

Summary of Changes Made

The Application was filed with 14 claims, and claims numbering up to 22 were later added. Claims 2, 3, 7-9, 11-14 had been canceled previously. Presently, claims 21 and 22 are canceled, while new claim 23 is added. Claims 1, 6, 10, and 16-20 are currently amended. Accordingly, claims 1, 4-6, 10, 15-20, and 23 (12 claims) are pending in the application. No new matter has been added.

Claim Rejections – 35 U.S.C. 112, second paragraph

Claims 10, 15, 16, 21 and 22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite. Each claim refers to the “aqueous solution” as further comprising active substances as well as auxiliary substances. Claim 16 recites broad categories of compounds which the Examiner admits further limits the category of “auxiliary substances.” While the Examiner contends that each category is known in the art, he finds it unclear what Applicants are claiming. Thus, Examiner continues to interpret the limitations of an “aqueous solution” as broadly as water (e.g. tap water).

Claim 1 has been amended to recite that the aqueous solution in step (b) comprises water. Claim 10 has been amended to recite that the aqueous solution of step (b) further comprises at least one selected from the group consisting of active substances and auxiliary substances. Based on the amendments to claims 1 and 10 in this regard, claim 15 is clear without amendment. Claim 16 has been amended to positively recite that the aqueous solution comprises an auxiliary substance selected from various choices. Claims 21 and 22 are canceled herein thus rendering the rejection thereof moot.

Claims 10, 15, and 16 are now clear and precise, and, regarding the present rejection as applied to claims 1, 10, 15, and 16, the dependent claims are narrower in scope than the claims from which they depend. Applicants respectfully request withdrawal of the rejection.

Claim Rejections – 35 U.S.C. 103(a)- (Kojima)

Claims 1, 4-6, 10 and 15-22 are rejected as obvious in view U.S. Pat. App. Pub. No 2002/0068683 to Kojima, (“Kojima”), newly cited. The Examiner characterizes the subject matter of claim 1 as a method of using a shaped article to apply at least one skeleton-forming agent to an external skin or hair surface of a human or animal comprising (1) providing a sized and shaped article, free of protein-based scaffolding agent, (2) disintegrating said article with an aqueous solution to form a solution or a gel, and (3) applying the composition to the intended surface.

The Examiner contends that the limitations “molded [and] freeze-dried” in claim 1 carry no patentable weight, as they are product-by-process limitations. The Examiner continues to interpret the recitation of an “aqueous solution” in claims 10, 15, 16, 21 and 22, as “contacting the shaped article with water (e.g. tap water)”. The shaped article is recited as further comprising one or more cosmetic or pharmaceutically active substances or one or more auxiliary substances such as squalane.

The Examiner contends that Kojima teaches a shaped, water-soluble solid composition that produces a lubricating liquid when dissolved in water. The Examiner alleges that the instantly claimed shape limitations are taught, such that the composition may be sphere-shaped as well as varied in size or dimension. Test Examples 1 and 2, for instance, teach the composition as being compressed and molded from a 30-mm cube into a shape (e.g. column) having a 12-mm diameter. Based on this teaching, a molded sphere, having a 12-mm diameter an approximate volume of 905 microliters is conceivable, thereby teaching the limitations of the instant claims 1 and 6. The limitations of claims 4 and 5 are taught such that the composition comprises a “solidifying agent” (claim 4), which is further defined as comprising sodium alginate [0018].

The Examiner contends that limitations of claims 17-20 are taught, such that the composition may contain one or more auxiliary substances or additives (Abstract; claim 1, [0024] and [0038]) as well as active substances such as antiseptics [0024]. Paragraph [0039] teaches the use of additives such as squalane. The limitations of claims 10, 15, 16, 21 and 22 are

taught such that the solid, shaped composition is contacted with an aqueous solution such as water prior to or concurrent with application of the composition to the skin.

The Examiner will note that claims 21 and 22 have been canceled thus rendering the rejection thereof moot. Further, claim 1 has been amended to recite that the article is porous. The limitation has been amended into claims 6 and 17-20 also. It is believed that the rejection is overcome on this basis alone, as Kojima fails to teach or suggest that a porous article.

While the Examiner believes that “freeze-dried” and “molded” are process limitations, the same cannot be said of “porous.” “Porous” is a state of being independent from any process. However, Applicants note that the limitation “porous” is found at page 22, 1st paragraph of the specification.

Based on all of the foregoing, Applicants respectfully request that Examiner withdraw the obviousness rejection over Kojima.

New Claim

New claim 23 has been added to round out Applicants' claim coverage. New claim 23 covers the embodiment where in step (a), prior to the contact step (b), the porous article of claim 10 itself already contains active and/or auxiliary substances and the aqueous solution involved in step (b) also includes active and/or auxiliary substances. New claim 23 finds support in the original form of claim 1 as originally filed as well as in the specification at page 4, lines 20-24. New claim 23 is clear and precise and also not obvious in view of the cited Kojima reference. Applicants respectfully request entry of the claim and an indication that it, along with claims 1, 4-6, 10 and 15-20, are patentable.

Conclusion

In light of the foregoing, it is respectfully submitted that the present application is in a condition for allowance and notice to that effect is hereby requested. If it is determined that the application is not in a condition for allowance, the Examiner is invited to initiate a telephone interview with the undersigned attorney to expedite prosecution of the present application.

If there are any additional fees resulting from this communication, please charge the same to Deposit Account No. 18-0160, Order No. GIL-16027.

Respectfully submitted,

RANKIN, HILL & CLARK LLP

By: / Christopher J. Korff /
Kenneth A. Clark
Reg. No. 32,119
Christopher J. Korff
Reg. No. 55,342

23755 Lorain Road - Suite 200
North Olmsted, 44070-2224
(216) 566-9700
docketing@rankinhill.com